



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/905,261	07/13/2001	John MacAlister	1965-1-3	4870

996 7590 07/23/2003

GRAYBEAL, JACKSON, HALEY LLP
155 - 108TH AVENUE NE
SUITE 350
BELLEVUE, WA 98004-5901

EXAMINER

AHMAD, NASSER

ART UNIT	PAPER NUMBER
----------	--------------

1772

12

DATE MAILED: 07/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS12

Office Action Summary

Application No.
09/905,261

Applicant(s)
MacAlister et al.

Examiner
Nasser Ahmad

Art Unit
1772



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 29, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above, claim(s) 20-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 24-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other: _____

Art Unit: 1772

1. Applicant's affirmation of election of group I, claims 1-19 and 24-40 with traverse in paper no. 11, filed on April 29, 2003 is acknowledged. However, in the absence of any ground(s) of traversal, the restriction is deemed to be proper and therefore made FINAL.
2. The rejection of claims 24-40 under 35 USC 112, second paragraph made in paper 9, paragraph - 15, mailed on December 23, 2002 has been withdrawn in view of amendments to overcome said rejection.
3. The rejection of claims 1-19 under 35 USC 103(a) over Kassab has been withdrawn in view of applicant's convincing argument.
4. Claims 24-29, 33 and 36-40 are rejected under 25 USC 102(e) as being anticipated by Kassab for reasons of record in paper no. 9, paragraph - 10, mailed on December 23, 2002.
5. Claims 24-40 are rejected under 35 USC 103(a) as being unpatentable over Kassab for reasons of record in paper no. 9, paragraph - 12.
6. Applicant's arguments filed April 29, 2003 have been fully considered but they are not persuasive. Applicant argues that Kassab fails to teach a mount having a first surface carrying an adhesive coating. This is not found to be persuasive because Kassab's mount does include an adhesive layer (34) and a sticker substrate (32) adhered to the mount. Further, the instant claims does not exclude the presence of additional layers in the mount assembly. It is also submitted that Kassab's examples of stickers is not limited as such because, as stated in col. 3, lines 46-48, the adhesive is disposed between the static cling mount and the sticker. This can be interpreted as the

Art Unit: 1772

adhesive being provided on the mount surface prior to the paper sticker being adhered to it. Also, applicant should note that all intended use phrase such as "for mounting", "capable of", etc. have not been given patentable weight for reasons of record in paper no. 9, paragraph - 10.

Thus, in the absence of any evidence to the contrary, it remains the Examiner's position that the claimed invention is anticipated or rendered obvious over the prior art of record discussed above.

7. In addition, the following are new grounds of rejection in view of newly uncovered prior art and amendment to the claims.

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

9. (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-2, 4-11, 13, 16-19, 24-30 and 33-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Shanley (5,403,025).

Shanley relates to a plurality of mounts adhered to a single sheet of backing material (22) in a roll form (25). Each of said mount label comprises a body assembly (20) which displays a first surface carrying an adhesive coating (21) and a second opposite surface without adhesive. As shown in the drawings, each mount is flexible with both first and second surfaces being flat. Each mount label is clear and comprises plastic material.

Art Unit: 1772

It is well known in the vinyl sheet making art to use plasticizer for static-cling property and the vinyl material would include polyvinyl chloride. The presence of indicia would include for the presence of pigment material.

The intended use phrases such as "for mounting", "capable of", "to form".

As for the method for securing the first material to a second material when a first material (22) is releasably adhering to the mount assembly (20) via adhesive (21) and securing a second surface of the mount to a second material (18) without adhesive.

Further, when the mount assembly is taken to be (18) and (20) together, the assembly is secured to a glass substrate.

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1-19 and 24-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shanley in view of Longtin (5,334,431).

Shanley, as discussed above, fails to teach that the mount assembly is in a sheet form. Longtin relates to static cling decal assembly having the structure as claimed and the assembly can be in a sheet form or a roll (col. 3, line 50). Longtin teaches that the mount label assembly being in sheet or roll form are functionally equivalent. Therefore, it would have been obvious to one having ordinary skill in the art to utilize Longtin's teaching of using sheet form assembly, instead of roll form, in the invention of Shanley with the motivation that both forms are functionally equivalent for storage convenience.


Art Unit: 1772

As for the amount of plasticizer in the plastic material (claim 12), up to 2mm thickness of each mount (claim 13) and surface area being 100-900 mm², it would have been obvious to one ordinary skill in the art to provide said amount, surface area, or thickness based on optimization through routine experimentation to impart optimum static-cling property, flexibility or adherence surface.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 703-308-4424. The examiner can normally be reached on Monday-Thursday from 7:30 am to 5 pm. The examiner can also be reached on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 703-308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


NASSER AHMAD
PRIMARY EXAMINER

N. Ahmad/mn
July 14, 2003